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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/615,078	07/08/2003	William O'Bryan	0328	7940
26612	7590	10/13/2004	EXAMINER	
DANIEL B. RUNK 1400 PROVIDENT TOWER ONE EAST FOURTH STREET CINCINNATI, OH 45202			LUONG, SHIAN TINH NHAN	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,078

Applicant(s)

1

Examiner

Shian T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a disc holder, classified in class 206, subclass 308.1.
  - II. Claims 12-16, drawn to a method of binding, classified in class 402, subclass unknown.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make other and materially different product such as the combination of a disc holder in a publication.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with applicant's attorney, Don Hasse, on 9/11/04, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 is indefinite because the term “the binding edge” lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-3, 8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by O’Mullane (Des. 435,188). O’Mullane discloses a disc holder comprising a top layer and a bottom layer wherein the top layer is within the boundary of the bottom layer. The edges of the layer are two or more sides of the holder. The layers are adhered together to form a pocket opening. The edge along the opening is the binding edge.

8. Claims 1-2, 6,10 are rejected under 35 U.S.C. 102(b) as being anticipated by McKinney et al (US 6,688,648). McKinney discloses a disc holder comprising a top layer 35 made out transparent plastic material and a bottom paper layer 25 wherein the top layer is within the boundary of the bottom layer. The edges of the layer are two or more sides of the holder.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinney. With respect to claim 7, the glue method is not a distinguishable feature in a product claim and hence it would have been obvious to use any glue method to adhere the base and top layers together. Similarly, claim 11 requires die-cutting, but it is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), In re Brown, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); In re Fessmann, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims. The zipper tab formed by cuts 46 allows a user to open the top layer to access the pocket.

11. Claims 3-5,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinney et al. in view of Dottel (US 6,250,460). McKinney et al. failed to disclose an opening on one side of the top and base layer and a partial glue line extends at an angle away from the insertion side. However, Dottel teaches a device for protecting CDs comprising a pocket formed by top and bottom layers. A connecting line that angles the pocket away from an opening to prevent inadvertent movement of the Cd. The binding edge is adjacent to one of the openings to the pocket. From the teaching of Dottel, one of ordinary skill in the art would readily recognize that more than one opening to the pocket may be established and the opening may be at an angle

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established by adhesive or weld line. Although the claim requires glue lines, McKinney did still meets the claims because it specified to the use of any adhesive for the package.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKinney et al. in view Official Notice. It would have been obvious to roughening the surface before binding. However, applicant is reciting a method step within a product claim. The patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985). Also note MPEP 706.03(e), In re Brown, 59 CCPA 1063, 173 USPQ 685 (CCPA 1972); In re Fessmann, 180 USPQ 324 (CCPA 1974) regarding the Office's lesser burden of proof in product-by-process claims.

### ***Conclusion***

13. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.


For applicant's convenience, the formal FAX number is (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which

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require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL  
October 10, 2004

  
Primary Examiner  
Shian Luong  
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